

### **REMARKS/ARGUMENTS**

Claims 1-17 and 20-24 have been cancelled and claims 18-19, 25-29 are remain under examination. The office action dated on November 30, 2007 includes the following rejections:

1. Claims 13, 16-19, 27 and 28 are rejected under 35 U.S.C § 112.
2. Claims 13, 16, 17 and 19 are rejected under 35 U.S.C §102(e) as being anticipated by Hellberg (US 2002/0165619).
3. Claims 13, 16, and 19 are rejected under 35 U.S.C §102(b) as being anticipated by Telikicherla (US 5,651,792)

Applicants have amended claim 18 to independent form and included all intervening claims. In addition claims 19 and 25-29 have been amended to depend from claim 18. Applicants submit claim 18 and dependent claims 19 and 25-29 are also in condition for allowance.

#### **Allowable subject matter.**

Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 18 has been revised in independent form to include all intervening claims. Applicants submit that claim 18 is now in condition for allowance and respectfully requests an early notice of allowance.

#### **Claims 13, 16-19, 27 and 28 are rejected under 35 U.S.C § 112.**

The Action has rejected claims 13, 16-19, 27 and 28 under 35 U.S.C §112 stating that the term “cosmetic” is indefinite. Applicants submit that the term cosmetic as defined as a cosmetic non-structural visual substitute for a missing limb is not indefinite and fully defined in the specification as filed.

The term cosmetic is fully defined in the specification and is therefore not indefinite. See

for example the second and third paragraphs of the specification below:

Elderly patients, in particular, after amputations are unable to handle prostheses that allow for walking or gripping. The reasons for this, on the one hand, reside in the bad physical conditions of elderly patients and, on the other hand, in poorer wound healing, which does not allow for the use of normal prostheses. Nevertheless, missing limbs also constitute mental problems in elderly patients, which is why there is a need for cosmetic prostheses.

In addition to a number of prostheses fulfilling walking and gripping functions, there have also existed prostheses for temporary use.

U.S.C. 112, second paragraph, demands only the language to be as precise as the subject matter permits and that claims, read in light of the specification, reasonably apprise those skilled in the art of the utilization and scope of the invention. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985); MPEP 7173.05(a). From the specification it is clear what “cosmetic” means and therefore defines the scope of the claims. Furthermore, the breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more. *See*, MPEP 7173.05(a); *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). In addition, there is no *in haec verba* requirement and the term “cosmetic” is supported in the specification expressly, implicitly, and/or inherently.

As a result Applicants respectfully request the withdrawal of the rejection of claims 13, 16-19, 27 and 28 under 35 U.S.C § 112 and allowance of the pending claims.

**Claims 13, 16, 17 and 19 are rejected under 35 U.S.C. §102(e)**

The action rejects claims 13, 16, 17 and 19 under 35 U.S.C §102(e) as being anticipated by Hellberg, U.S. Patent Application Number 2002/0165619 (Hellberg). Applicants respectfully submit that the cited reference fails to meet the standard of 35 U.S.C. §102(e) as Hellberg does

not disclose each and every limitation of the present invention.

Hellberg simply does not **identically disclose every element** of the claimed invention. See *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). A reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

The present invention provides a **light prosthesis as a visual substitute for a missing limb**. Hellberg is nothing more than a “thermoplastic liner blank” as suggested by the title. Hellberg simply does not provide a **visual substitute for a missing limb**. Hellberg teaches a liner blank, see paragraph [0002] and [0054] of Hellberg below:

[0002] The present invention relates to a soft and elastic prosthetic sleeve, and more exactly to a liner blank provided for customizing through thermoplastic deformation and adaptation to the individual wearer of a prosthetic device.

[0054] An advantage of the thermoplastic liner blank according to the present invention is that it is simple to afterwards perform small adjustments. If the amputation stump somewhat changes its appearance, the corresponding changes are performed to the earlier copy and the liner is again placed on the copy and heated, whereby after cooling it will maintain the new shape and regain the inherent elasticity of the elastic material.

Hellberg **DOES NOT teach** a shaped body (1) for replacing the missing limb comprises a socket (2) for connecting the prosthesis to a stump (3) of the missing limb, wherein the shaped body (1) is made of a light synthetic material, and that the periphery of the socket (2) for connecting the prosthesis to the stump (3) is variable, wherein the prosthesis is cosmetic and has a shape that is **a visual substitute for a missing limb**.

As Hellberg does not **identically disclose every element** of the claimed invention, anticipation has not been established and Applicants request withdrawal of the rejection under 35 U.S.C §102(e) and an early notice of allowance.

### **Claims 13, 16 and 19 are rejected under 35 U.S.C. § 102(b)**

The action rejects claims 13, 16 and 19 under 35 U.S.C §102(b) as being anticipated by Telikicherla, *et al.* U.S. Patent Number 5,651,792 (Telikicherla). Applicants respectfully submit

that the cited reference fails to meet the standard of 35 U.S.C. §102(b) as Telikicherla does not disclose each and every limitation of the present invention.

Similarly, Telikicherla does not **identically disclose every element** of the claimed invention. See *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). A reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Telikicherla does nothing more than teach a WEIGHT BEARING structural prosthetic device. As stated in the Abstract of Telikicherla below:

~~A lower limb prosthetic assembly for immediate post-operative amputation applications includes a temporary weight-bearing prosthetic device and an independent removable, replaceable, size-adjustable dressing adapted for immediate post-operative placement around the patient's amputation stump. The temporary weight-bearing prosthetic device includes an adjustable support member, and an open~~

It is clear from the disclosure of Telikicherla that the lower limb prosthetic assembly is STRUCTURAL in nature, does not allow a simple connection to the stump of the missing limb and is not a light-weight prosthesis and **cannot** serve as a light prosthesis according to the present patent application and as a **visual substitute for a missing limb or a cosmetic and non-structural** missing limb.

Telikicherla does not meet the standard of 35 U.S.C. § 102 as it excludes elements (no matter how insubstantial or obvious) claimed in the present invention, and this is enough to negate anticipation. See *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989) and *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Applicants respectfully submit that claims 13, 16, and 19 are not anticipated by Telikicherla and respectfully request the withdrawal of the rejection under 35 U.S.C. § 102.

### **CONCLUSION**

Applicants respectfully submit that the claims in the application are in condition for allowance. Favorable consideration and allowance of the pending Claims is therefore respectfully requested.

Applicants have amended claim 18 to independent form and included all intervening claims. In addition claims 19 and 25-29 have been amended to depend from claim 18. Applicants submit claim 18 and dependent claims 19 and 25-29 are also in condition for allowance. The Examiner is invited to contact the undersigned with any questions, comments or suggestions relating to the referenced patent application.

Dated this February 29, 2008.

Respectfully submitted,  
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